

Remarks

Claims 14, 16, and 17 were pending in the above-identified application when last examined. Claims 14, 16, and 17 are presented for reconsideration and allowance.

Claim Rejection under 35 U.S.C. § 103

Examiner rejected claims 14 and 16 under 35 U.S.C. 103(a) as being unpatentable over Feng et al. (U.S. Patent Number 6,727, 530) in view of Applicants' admitted prior art. Applicants respectfully traverses this rejection.

Appellants respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness because, among other reasons, there is no suggestion or motivation to combine the reference teachings as proposed by the Examiner. In the rejection, the Examiner asserts that all of the elements of applicants' claims can be found in the prior art references. This, however, is **not** the proper test for obviousness.

"It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."

Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

The Examiner has provided no basis for a teaching or suggestion in the prior art for combining elements as proposed in the rejection. The Examiner's argument regarding obviousness is as follows:

...it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Feng et al. ('530)* by the emitter comprising a first sidewall with a first reentry feature consisting entirely of a first undercut profile as taught by Applicant's admitted prior art to minimize base resistance (para 3 & 4).

(Office action, page 3)

The single sentence italicized above represents the Examiner's only explanation regarding a teaching or suggestion to combine. This sentence, however, is simply an *unsupported statement* made by the Examiner. In order to establish a *prima facie* case, a teaching or suggestion to combine must be found in the prior art. See, e.g., *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, *supra*. Such an unsupported statement, however, cannot constitute the evidence required to establish existence of a motivation or suggestion to combine:

Whether the Board relies on an express or an implicit showing [of a motivation, suggestion or teaching to modify the teachings of a reference], it must provide particular findings related thereto.... Broad conclusory statements standing alone are not "evidence".

In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembicza*k, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999))

Accordingly, the Examiner's statement does not constitute a showing of a teaching or suggestion to combine. At the very least, an Examiner must prove that some motivation or suggestion to combine can be found in knowledge generally available to one of ordinary skill in the art. In the present case, however, the Examiner provides no evidence that the requisite knowledge is generally available but, instead, attempts to rely on his own personal opinion. Such personal opinion does not represent an adequate substitute for evidence.

In short, it appears that the Examiner's proposed combination of Feng et al. and Applicants' admitted prior art is based solely on hindsight derived from applicants' specification. The use of hindsight in this manner is clearly prohibited by the relevant case law:

Obviousness can not be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). As discussed in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

In re Dance, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)

Obviousness may not be established using hindsight. See *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

For at least the above reasons, Applicants request reconsideration and withdrawal of the rejection of claims 14 and 16 under 35 U.S.C. § 103(a).

Examiner rejected claim 17 under 35 U.S.C. 103(a) as being unpatentable over Feng et al. (U.S. Patent Number 6,727, 530) in view of Applicants' admitted prior art as applied to claim 14 above, and further in view of Feng et al. (U.S. Patent Number 6,770,919). Applicants respectfully traverses this rejection.

Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case of obviousness because, among other reasons, there is no suggestion or motivation to combine the reference teachings as proposed by the Examiner. In the rejection, the Examiner asserts that all of the elements of applicants' claims can be found in the prior art references.

The Examiner has not shown that each of the three references teach or suggest combining all the necessary elements. At the very least, an Examiner must prove that some motivation or suggestion to combine can be found in knowledge generally available to one of ordinary skill in the art. In the present case, however, the Examiner provides no evidence that the requisite knowledge is generally available but, instead, attempts to rely on his own personal opinion. Such personal opinion does not represent an adequate substitute for evidence.

In short, it appears that the Examiner's proposed combination of Feng ('530), Applicants' prior art, and Feng ('919) is based solely on hindsight derived from appellants' specification.

For at least the above reasons, Applicant requests reconsideration and withdrawal of the rejection of claim 17 under 35 U.S.C. § 103(a).

Conclusion

Applicants respectfully submit that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby requested.

Respectfully submitted,

June 21, 2007

/John Pessetto/

John R. Pessetto, Reg. No. 48,369
KLAAS, LAW, O'MEARA & MALKIN, P.C.
P.O. Box 1920
Denver, Colorado 80201-1920
Tel. (303) 298-9888
Fax (303) 297-2266